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09/319,243	08/05/1999	PING LIONG TJOA		2663

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EXAMINER
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HAMILTON, LALITA M

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* PING LIONG TJOA

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Appeal 2008-5860  
Application 09/319,243  
Technology Center 3600

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Decided: February 12, 2009

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*Before* ANTON W. FETTING, DAVID B. WALKER, and JOSEPH A.  
FISCHETTI, *Administrative Patent Judges*.

WALKER, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 12 and 14-23. We have jurisdiction under 35 U.S.C. § 6(b) (2002). This appeal includes a record that is not ripe for review pursuant to 37 C.F.R. § 41.50(a)(1) (2007). We therefore remand this

application to the Examiner to take appropriate action consistent with our comments below. 37 C.F.R. §§ 41.35(b) and 41.50(a)(1) (2007).

This case was formerly remanded to the Examiner by the Board in a decision mailed November 30, 2004 (Remand to the Examiner, Paper No. 33, Nov. 30, 2004). The former Decision remanded the case to the Examiner to perform four actions:

- (1) The examiner shall identify what the differences are between the weight-training-device-of Bosko and the subject matter of each of the appealed claims, and in particular, independent claim 12. In so doing, the examiner shall state whether the limitations of claim 12 calling for the claimed apparatus to have spherical end elements of a diameter “adapted to the palm of the hand” and a total length “approximately in the range of the length of the shoulder span of the person using it” are “obvious” in view of Bosko (as per the rejection of Paper No. (15)) or “disclosed” (and thus fully met) by Bosko (as per the answer).
- (2) If the examiner determines that there are no differences between the subject matter of any appealed claim and Bosko, the examiner shall take appropriate action (e.g., enter a rejection of that claim under 35 U.S.C. § 102 as being anticipated by Bosko), or explain why such action has not been taken.
- (3) The examiner shall state for the record which, if any, of appellant's submissions accompanying the main brief have been entered.
- (4) With respect to any such submission entered, the examiner shall fully treat the submission on the record, explaining why the submission is or is not sufficient to overcome the rejection(s).

(Remand to the Examiner, 4-5). The referenced submissions accompanying the main brief were “two (2) executed Declarations under 37 CFR § 1.132, a brochure relating to the claimed invention, and an additional exhibit also relating to the claimed invention” (Remand to the Examiner, 3).

The Examiner reopened prosecution and addressed remand directions (1) and (2) in a Non-Final Office Action dated September 13, 2005. The Examiner did not respond to remand directions (3) and (4) in the Non-Final Office Action. After further prosecution, the Appellant filed a Brief on Appeal dated August 28, 2006, to which the Appellant attached a product brochure and two Declarations under 37 C.F.R. § 1.132, one from Dr. Karl-Michael Reinauer and the other from Barbara Michalski. These were the same product brochure and Declarations referred to in remand directions (3) and (4) above. The Appellant argues that

Applicant was not told in the Office Action of February 27, 2006, what effect these declarations had or why they were not effective.

. . . .

. . . To state that they were considered but were dismissed because the “[t]he apparatus claim limitations . . . are disclosed by Bosko is not enough, and has little meaning with respect to a 103 rejection. The declarations are from professionals that have used the training apparatus and seen the positive results achieved. They certainly show commercial success, and that is one reason they were offered. If the examiner does not agree, then applicant is entitled to know why.

(Br. 5-6). The Appellant also argues in the Reply Brief that

Two declarations under 37 CFR 1.132 were submitted in this case. The Board in its remand to the examiner, instructed the examiner to “. . . fully

treat the submission on the record, explaining why the submission is or is not sufficient to overcome the rejection(s),” (page 5 of the Board's remand (Paper No.33). It is respectfully submitted that this has not been done. That is, the examiner's statement on page 7 of the Examiner's Answer that “...the Examiner has given consideration to the declarations..... the Examiner did not find that the declarations helped to place the application in condition for allowance.” Is not the treatment intended by the Board.

Reference is made to MPEP 716, which provides guidance on treating declarations under 37 CFR 1.132. Section 716 instructs the examiner, if he/she does not believe that the declaration overcomes the rejection(s) to state why. See page 700-286 of the MPEP. The examiner has not followed the outlined procedure. The outcome should be acceptance of the declarations and withdrawal of the rejections.

(Reply Br. 3-4). The Appellant thus argues that the two declarations provide evidence of commercial success that has not been properly addressed by the Examiner.

We have reviewed all actions by the Examiner on the record since the previous remand, and find the following statement by the Examiner in the Answer relevant to remand directions (3) and (4) above:

The Appellant argues that the Examiner has not given the declarations its due consideration. In response, the Examiner has given consideration to the declarations. Bosko disclosed the structural limitations of the claimed invention. Thus, the Examiner did not find that the declarations helped to place the application in condition for allowance.

(Answer 7). The Examiner thus has not addressed the product brochure at all and has not fully explained why the two Declarations, which appear to have been entered and considered, are or are not sufficient to overcome the rejections. This fails to comply with the Board's direction in the former Remand to fully treat on the record any of the submissions accompanying the main Brief that have been entered, explaining why the submission is or is not sufficient to overcome the rejection(s).

Accordingly, we remand the case to the Examiner to comply with remand instructions (3) and (4) from the previous Remand to the Examiner. Specifically, the Examiner shall state for the record whether the product brochure submitted by the Appellant has been entered. Moreover, the Examiner shall reconsider the obviousness of claims 17-21 over the cited prior art, considering the extent to which the two Declarations and the product brochure, if entered, provide evidence of secondary considerations relevant to the nonobviousness of claims 1-65 as required by *Graham v. John Deere Co.* *Graham*, 383 U.S. at 17-18. In each case, the Examiner shall fully treat the submission on the record, explaining why the submission is or is not sufficient to overcome the rejections.

#### ORDER

Accordingly, it is ORDERED that the application is remanded to the Examiner:

- 1) to state for the record whether the product brochure submitted by the Appellant has been entered;
- 2) to weigh the evidence submitted by Appellant as evidence of secondary considerations of nonobviousness;

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4) to reconsider the extent to which Bosko, Coalier, Jackson, and other available prior art render obvious the subject matter of claims 17-21 in light of the Appellant's evidence of secondary considerations, fully treating each entered submission on the record, and explaining why the submission is or is not sufficient to overcome the rejections; and

5) for such further action as may be appropriate.

REMANDED

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